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In the Supreme Court of the United States

OCTOBER TERM, 1970.

No. 305.

SKEGA AKTIEBOLAG
(formerly Skelleftea Gummifabriks A.-B.)

and

THE ALLEN PUMP CO.
(Trading as The Allen-Sherman-Hoff Pump Company),
Petitioners,

vs.

THE B. F. GOODRICH COMPANY,
Respondent.

PETITION FOR REHEARING OF THE PETITION FOR WRIT OF CERTIORARI IN THIS CASE WHICH WAS DENIED ON OCTOBER 12, 1970.

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Petitioners request a rehearing of their Petition for Writ of Certiorari which was denied by this Court on October 12, 1970.

The grounds for this request are the questions and reasons set forth in the said petition and the following additional reasons, all relating to the meaning and construction of the Statute, 35 U.S.C. 103, which was the basis for the petition.

Greater non-uniformity and diversity of decisions regarding that Section 103 have occurred since February 21, 1966, than had occurred in the previous 14 years, i.e., back to January 1, 1952, when that statute was enacted. The

decisions of the appellate courts had been so non-uniform and diverse during that 14-year period that this Court felt impelled to construe and state the requirements for decisions under that section.

This Court granted petitions for certiorari in three cases decided by the Court of Appeals for the Eight Circuit, i.e., *Graham v. John Deere; Calmar, Inc. v. Cook Chemical Company* and *Colgate-Palmolive v. Cook Chemical Company;* and one case from the Court of Claims, *U. S. v. Adams.* These several cases were decided on February 21, 1966, and are reported in 383 U.S. 1-52.

Three years later, this Court repeated those instructions in the case of *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (Dec. 8, 1969). In both the *Graham* and *Black Rock* cases, this Court expressed the hope that its instructions, set forth in those decisions, would result in uniformity and certainty of patent decisions. However, that hope has not been realized.

The stream of patent decisions split into two oppositely divergent branches after passing the "three basic factual inquiries" of the *Graham* case. The rock which split that stream was the issue of when the "secondary considerations" may be used.

There are two lines of decisions which illustrate the divergent views of the courts on this issue. One line of cases holds that the secondary considerations may be used in all cases, even where the question of non-obviousness is close and in cases where the combination of old elements is present. The other line of cases holds that the secondary considerations may not be used under either of those just stated conditions, nor where obviousness is clear, or the patent teaches nothing of significance, and no matter how useful the patented device has been, or how long and by how many it was sought.

The first line of decisions is illustrated by the following cases:

CA 1 *Columbia Broadcasting System v. Sylvania Electric Products, Inc.*, 415 F.2d 719 (cert. denied 396 U.S. 1061).

CA 5 *Zero Manufacturing Co. v. Mississippi Milk Producers Association*, 358 F.2d 853.

CA 5 *National Athletic Supply Corp. v. Muscle-Matic, Inc.*, 164 USPQ 330, affirming 164 USPQ 10.

Ct. Cls. *Palmer v. United States*, 165 USPQ 88, affirming 163 USPQ 250.

CCPA *Application of Roy A. Grout*, 377 F.2d 1019.

CCPA *Application of VanWonderham*, 378 F.2d 981.

CA 7 *Mercantile National Bank of Chicago v. Quest, Inc.*, 166 USPQ 513 (Aug. 13, 1970).

CA D.C. *Higley v. Bremmer*, 387 F.2d 855.

The second line of decisions is illustrated by the following cases:

CA 2 *Continental Can Company v. Old Dominion Box Company*, 393 F.2d 321.

CA 3 *Continental Can Company v. Crown Cork Company, Inc.*, 163 USPQ 1 (cert. denied 90 SCR 916).

CA 6 *Kaiser Industries Corporation v. McLouth Steel Corporation*, 400 F.2d 36 (cert. denied 393 U.S. 1119).

CA 6 *Eisele v. St. Amour*, 423 F.2d 135.

CA 6 *The present case*, 420 F.2d 1358 (cert. denied Oct. 12, 1970).

CA 8 *National Connector Corporation v. Malco Manufacturing Company*, 392 F.2d 766.

CA 9 *Spring Crest Company v. American Beauty Pleat, Inc.*, 420 F.2d 950.

CA 9 *Carborundum Company v. Wilbanks, Inc.*, 420 F.2d 43.

Because of the divergent views of the several courts as indicated in the foregoing lines of decisions, it is virtually a foregone conclusion that if any of the patents sustained in the first line of decisions were submitted to the courts which decided the cases in the second line of decisions, such patents would not have been sustained.

By the same token, if any of the patents held invalid in the second line of decisions were to be submitted to the courts involved in the first line of decisions, it is also extremely probable that those patents would be sustained.

The confusion and uncertainty resulting from the foregoing diversity of decisions was not reduced and may have been increased by the failure of this Court to grant petitions for certiorari from the two lines of decisions, such as *Columbia v. Sylvania* in the first line and *Kaiser v. McLouth* and the present case in the second line.

In view of the utter confusion which exists in the patent law because of the conflicts and diversities of decisions now existing, it would seem to be high time for this Court to speak out and settle the conflicts so that the decisions in patent cases may attain the object of uniformity and certainty which was expressed in the *Graham* case.

The statute, Section 103, did not refer to "factual inquiries" or "secondary considerations." While the *Graham* case mentioned both those inquiries and considerations, it placed no restriction on the use of the considerations except that they were to be directed to the issue of non-obviousness or obviousness.

There is no apparently good reason why the secondary considerations should not be used in every case. They are susceptible of proof, and fact proof is required to support a conclusion of obviousness which is a matter of law, as was stated in the *Graham* case. Indeed, in the *Adams* case, secondary considerations were used in sustaining the patent.

There is no apparently good reason why fact proof of secondary considerations may not be used in a "close case" for that is where it may be most needed.

There is no apparently good reason why fact proof of secondary considerations should be brushed aside and a decision of obviousness made without any proof support.

Petitioners respectfully request that this petition for rehearing be granted.

Respectfully submitted,

B. D. WATTS,
Attorney for Petitioners.

Cleveland, Ohio
Nov. 6, 1970.

Certificate.

I hereby certify that the foregoing petition is brought under Rule 52(2) of the Rules of the Supreme Court of the United States; that the said petition is presented in good faith and not for delay, that the petition is restricted to the grounds originally presented and that the additional grounds above noted are substantial and were available to petitioners although not previously presented.

I further certify that this petition has been served on Counsel for the Respondent.

B. D. WATTS,
Attorney for Petitioners.

Nov. 6, 1970.